



Docket No.: 848075-0061

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Takayuki YAJIMA

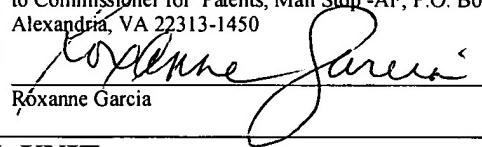
Serial No.: 10/716,118

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For: **PORTABLE TERMINAL UNIT**

Examiner: Ma, Calvin

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal signed by the undersigned, Applicant's counsel.

The review is requested for the reason(s) stated below.

## REMARKS

This request for review is filed in response to the final Office Action dated September 23, 2010, directed to pending claims 1-20 and 26-28 of which claims 1, 8 and 15 are independent. All claims stand rejected. The Examiner has rejected all pending claims as obvious over combinations of either: Finke-Anlauff (US Patent No. 6,850,226) in view of Lenchik (US Patent No. 7,257,430), Will (U.S. Patent No. 5,825,352), and Valliani (US. Patent No. 6,234,389).

Although the Examiner cites to and combines many references in rejecting the pending claims, the cited art, alone and in combination, still fails to disclose or even suggest all claimed elements as necessary to make a *prima facie* showing of obviousness. Focusing on independent claim 8, which the Examiner has determined to be the broadest pending claim, claim 8 is not rendered obvious because the cited prior art fails to disclose or suggest, at least, the claimed elements, as discussed below, and there has been no showing by the Examiner that those elements are or would be within the knowledge or understanding of one of ordinary skill in the art. The Examiner has asserted incorrectly that those missing elements are found in the cited prior art for the following reasons.

Claim 8 recites at least the following elements and the cited prior art as properly interpreted does not disclose or suggest any of these elements alone or in combination:

wherein in the closed state said control section controls said display section to display thereon an item selecting screen for **selecting an item from a plurality of items**, and [**“CLAIM ELEMENT 1”**]

wherein in a state where a specific item which requires a text input operation by the main operation section is selected from the plurality of items on the item selecting screen, in response to a state change from the closed state to the opened state, the control section controls said display section to **change from the item**

**selecting screen, into displaying a text input screen for the selected specific item, [“CLAIM ELEMENT 2”]**

wherein in a state where a specific item which requires a text input operation by the main operation section is selected from the plurality of items on the item selecting screen, **in response to that selection of the specific item** is determined by the auxiliary operation section, said control section controls said display section to display thereon a message screen prompting a user to change said portable unit from the closed state into the opened state, and [“CLAIM ELEMENT 3”]

wherein said control section controls said display section to display thereon **a text input screen for the selected specific item in response to a state change from the closed state to the opened state.** [“CLAIM ELEMENT 4”]

First, the Examiner is wrong because the cited prior art does not disclose “wherein in the closed state said control section controls said display section to display thereon an item selecting screen for selecting an item from a plurality of items.” Second, in applying the cited art against the remainder of claim 8, the Examiner assumes without any support that the prior art discloses an “item selecting screen for selecting an item from a plurality of items.” For example, the Examiner relies on Lenchik as disclosing a selecting screen for selecting an item from a plurality of items where an item is selected from the plurality of items on the item selecting screen in response to a state change from the closed state to the opened state. *See Office Action at 4.* This reliance, however, is wrong because Lenchik does not disclose an item selection screen having a plurality of items from which an item is first selected and after an item is selected THAT SELECTED ITEM from the plurality of items is activated in response to a state change from the closed state to the opened state. Accordingly, Lenchik cannot disclose Claim Elements 2-4 of claim 8, as described above.

The Examiner also relies on the combination of Will and Lenchik for disclosing “**in response to that selection of the specific item is determined by the auxiliary operation section, said control section controls said display section to display thereon a message screen**

prompting a user to change said portable unit from the closed state into the opened state.” See Office Action at 5-6. This is incorrect because in Lenchik the message screen is not prompted by the selection of a specific item from an item selecting screen displaying a plurality of items. Rather, Lenchik discloses a message or alert that provides notice of a **non-selected** item, unlike the specific item that is selected from the plurality of items as claimed.. See Lenchik at Col. 4, lines 61-63 (“The portable electronic device 100 may include an alert that notifies the user that a **non-selected service** is waiting to be received, such as an incoming page in this example.”).

Excerpt for Lenchik, the Examiner agrees that the cited prior art “does not explicitly teach in a state where a specific item is selected from the plurality of items of the item selecting screen, in response to a state change from the closed state to the opened state, the control section controls said display section to change into display a screen for the selected specific item from the item selecting screen.” Office Action at 4. The Examiner argues that in Lenchik, “the screen movement allow for automatic activation of different applications based on the self- configuration system of the processor in the main body of the phone, and the ability to notify the user of non-selected service waiting to be received such as incoming page, where when the user reconfigure the device, the device response and the display shall change to support such functional change.” See Fig. 1, Col. 4, Lines 45-67).” Office Action at 4. However, even assuming this to be true, Lenchik does not allow for automatic activation of an item selected from a plurality of items in response to the opening and closing of the device.

Lenchik discloses a portable electronic device that attempts to match the orientation of the display to the orientation of the device. See Lenchik Col. 3, lines 40-43 (“The orientation of the display 120 may be self configured by the device 100 to match the overall orientation of the self-configuring multiple element portable electronic device.”) Because the

device may be oriented multiple ways, the device includes differently oriented keys that may be used depending on the orientation of the device. In fact, Lenchik discloses a device that is configured in only two modes of operation. Lenchik explains “the user may position the two elements 104 and 106 to cause the portable electronic device 100 to self configure as a cellular phone and receive incoming phone calls” or the user may “reposition the elements of the device 100 in order to cause the device 100 to self configure as a pager, whereupon the incoming page may be received and/or responded to.” Col. 4, lines 58-67. Thus in Lenchik the user may switch between two modes of operation by changing the orientation of the device and not from an item selection screen having a plurality of items.

Lenchik, like Finke-Anlauff, and unlike the claimed device, fails to disclose a device having an item selecting screen for selecting an item from a plurality of items wherein an item is selected from the plurality of items on the item selecting screen in response to a state change from the closed state to the opened state. In other words, none of the cited references disclose selecting an item from a plurality of items by opening the device. Also, and as previously explained, the Examiner has misunderstood the notice/alert function described in Lenchik and wrongly applied Lenchik and Will to render claim 8 obvious. The combination of Will and Lenchik is also unreasonable because Lenchik discloses activating a function by changing the relative position of elements (housings), and it is, therefore, not necessary to provide the feature of selecting and activating an operation by a thumbwheel and auxiliary operation selection. As the Examiner has analyzed claim 8, as the broadest claim, Applicant’s arguments apply equally to independent claims 1 and 15 and all the pending dependent claims. For the foregoing reasons, Applicant respectfully submits pending claims 1-20 and 26-28 are allowable over the prior art of record.

The undersigned requests, on behalf of the Applicant, that the remarks in this pre-appeal brief request be considered and that, for the foregoing reasons, there are clear errors in the Examiner's rejections, namely, the Examiner's reliance on Lenchik, which does not disclose the claimed elements as argued by the Examiner. Thus, there is an absence of one or more essential elements for a prima facie rejection. Accordingly, Applicant requests a finding by the Panel that the application is allowed on the existing claims and prosecution is closed.

In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-0675, Order No. 848075-0061.

Respectfully submitted,



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Date: January 21, 2011  
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